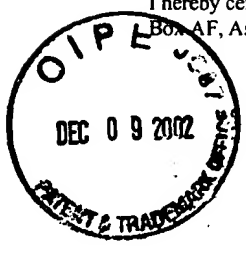


#1 Board of Appeals  
EOTCZ



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December 2, 2002  
(Date)

Albert W. Watkins  
Name of applicant, assignee, of registered representative

*Albert W. Watkins* 02 dec 2002  
Signature Date of Signature

# APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re:

Serial #: 09/589,866  
For: Tag-Along Teacher Educational Aids  
Filed: June 8, 2000  
Inventor: Lorna B. Voit  
GAU: 3712  
Examiner: Nguyen, Kien T.  
Docket #: Voit Tag

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## APPEAL TO THE BOARD OF APPEALS

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01 FC:2251 55.00 DA

Appellant respectfully appeals from the Examiner's final rejection of claims 1, 4, 5, and 7 - 17.

Please charge all fees for this correspondence to deposit account 17-0155.

### 1. REAL PARTY IN INTEREST

The present patent application is owned by the above named inventor.

02/10/2002 EREMBRY1600000002 170155 09589866

Adjustment date: 08/08/2003  
12/17/2002 SZIMERN 00000001 0155 09589866  
01 FC:2252 200.00 CR

## 2. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

## 3. STATUS OF CLAIMS

Claims 1, 4, 5, and 7 - 17 are pending. Each of these claims stand finally rejected, and are the subject of the present appeal.

## 4. STATUS OF AMENDMENTS

No amendments are pending.

## 5. SUMMARY OF THE INVENTION

### The Invention, Generally

This invention pertains generally to the field of education, and more specifically to the learning of languages and vocabulary. The present invention combines a key ring (110, fig 1), key (120, fig 1), and an educational tag (140, fig. 1) to provide both apparatus and method that greatly simplify learning. The combination capitalizes on the pervasiveness of keys, which are carried by nearly every adult in society, and how frequently those keys are used. In a single day, as detailed in the present specification on page 8 in the paragraph beginning in line 10, a typical person will access a key ring at least eight different times, and use the keys eleven times. Each of

these accesses is turned into another opportunity for learning, with essentially no burden on the person. The inventive combination is unobtrusive, durable, expandable, easily and flexibly manufactured, packs efficiently, and provides self-paced learning.

#### Exemplary Claim 7

A method for expanding vocabulary, comprising the steps of:

identifying vocabulary words (146, fig 1) and definitions (147, fig 2) that define each of said vocabulary words (page 11, lines 3 - 4);

imprinting said identified vocabulary words onto tags (140, figs 1 - 3) on a first surface (142, fig 1) thereon, one of said vocabulary words for each one of said tags (page 10, lines 8 - 10, and fig 1);

imprinting said definitions that define said vocabulary words onto said tags on a second surface (143, fig 2) thereon opposed to said first surface wherein each tag contains at least one vocabulary word and at least one definition that defines said at least one vocabulary word (146) (page 10, lines 8 - 10, fig 2);

selecting a one of said imprinted tags (page 11, line 6);

inserting said selected one imprinted tag onto a key ring together with a key removably attached therewith (page 11, lines 7 - 14);

storing said key ring, said key and said inserted, imprinted tag (page 11, lines 14 - 16);

retrieving said stored key ring (page 11, lines 16 - 17);

transporting said key ring, said key and inserted, imprinted tag through the natural elements without shelter (page 7, lines 1 - 3, page 9, lines 20 - 21 and page 11, lines 13 - 14);

stowing said retrieved key ring (page 11, line 17); and

studying said selected one imprinted tag between said step of retrieving and said step of stowing (page 11, lines 17 - 20).

## 6. ISSUES

A. Whether under 35 U.S.C. § 103(a) claims 1, 4, 5, and 7 - 17 are unpatentable over Peckham in view of Luciano.

## 7. GROUPING OF CLAIMS

For the purposes of this appeal, claims 4, 5, 12 and 13 will stand and fall with the associated independent claim. The claims of each remaining group do not stand or fall together with regard to issue A of section 6 above. Particularly, and for reasons specifically set forth in the arguments section 8 of this appeal brief, claims 1, 4, 5, and 7 - 17 define through three different independent claims various combinations and features of elements, including both apparatus and method. The dependent claims not identified within this paragraph herein above define the invention in progressively more distinctive terms for which separate novelty is claimed.

## 8. ARGUMENTS

### I. REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

There are no outstanding rejections with basis in this section of the statutes.

## II. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

There are no outstanding rejections with basis in this section of the statutes.

## III. REJECTIONS UNDER 35 U.S.C. § 102

There are no outstanding rejections with basis in this section of the statutes.

## IV. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 4, 5, and 7 - 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peckham in view of Luciano. In the outstanding office action, on page 2 beginning in the eighth line of the last paragraph of that page, the Examiner outlines the primary basis for the rejection which forms a major issue of the present appeal. Therein, the Examiner states: "It is noted that Peckham failed to teach the use of a key ring and a key attached to the tags **for portability. . . Although Luciano did not show a key actually attach to the key chain, it is inherent that a key chain typically includes a key.** Therefore, it would have been obvious to one of ordinary skill in the art to modify the educational device of Peckham . . . for the purpose of allowing the user to conveniently carry the device around." It is the opinion of the applicant

and her representative that the Examiner has misrepresented the content, and consequently the teaching, of the Luciano reference.

### The Luciano Patent

The Luciano reference, as also acknowledged by the Examiner, does not explicitly teach the combination of key, key ring, and educational tag. Instead, Luciano illustrates a fragile electronic device, having a slot wholly through the center thereof, attached to a ring of the type used on a key chain for storage securement to a question book. The first question before the Board then is whether Luciano's recitation of a key chain attachment when considered in combination with the closed ring of Peckham, teaches the applicant's recited combination of a key with a key ring and an educational tag. The appellant does not believe this to be what the Luciano reference would teach to one of ordinary skill in the field, for a number of different reasons.

As noted in appellant's specification and herein above, a key ring carrying keys is used by nearly every adult many times each day. The key ring is exposed to shock when dropped, bending forces when other objects are pressed against the ring, either in a purse or pocket, vibration when used in an automobile, and harsh environmental conditions such as both elevated and freezing conditions, moisture from rain and snow, and a myriad of other elements that are destructive to sensitive electronics. The Luciano reader, which includes a display and contacts within the open center, is referenced and described as a smart card reader. The Examiner will recognize that smart card readers are constructed very differently from a smart card which only needs to protect the chip. As the Examiner may know, or can readily confirm, constructing a smart card durable enough to survive both mechanical and environmental exposure typical with

being carried about by a person in the ordinary course of activities is quite demanding. Current technology only makes this viable for a chip embedded in a carefully reinforced card. These cards are not open to the elements. The Luciano device 11 is the reader, and is constructed quite differently from known smart cards. Dirt, mud, snow and the like within the open core of the Luciano reader 11 will lead to failure, as will any mechanical stresses, since the open core provides a weakened structure. In addition, the Luciano reader 11 must include a very fragile digital display 21, which is much larger and also much more fragile than any chip embedded within a smart card. The Examiner will recognize that, in order to make smart cards viable, the card structure is solid and quite rigid immediately in the vicinity of the electronic components. One skilled in the art of smart cards and the like will recognize that the Luciano reader 11 is, in fact, a frail and fragile device which is not viable for general transport with a person's keys. Consequently, the teachings that might appear to be inherent or obvious are, in fact, contrary, since Luciano instead inherently cannot withstand exposure to the elements.

For these reasons, the Luciano reader would not have been intended to be carried with and used in association with the use of keys as recited in the claims. Instead, the appellant contends that this ring illustrates one type of readily available means for attachment, in all probability selected by the inventor because a key ring was at hand at the time Luciano conceived of the invention. Whether by convenience and availability, as is common in the world of invention, or strictly to meet the enablement requirements of the statute, or for some other reason we will not know, Luciano merely disclosed a key ring for attachment capability. However, we can with certainty state that the Luciano device would be destroyed if used with an ordinary key, and cannot therefore be interpreted as teaching such combination with a key.

Further compounding this difficulty of combining a key with the Luciano device is the

thinness of the Luciano device, and the slot cut through the middle. Keys on a key ring will not only interfere with the use of the reader, they would further expose the reader to risk of damage. For anyone who has had the experience, the key would, in fact, end up within the slot and undoubtedly destroy the contacts, if not directly breaking the reader. There is no actual teaching of the further combination of a key in Luciano, and, in fact, the combination with a key would be adverse or destructive to the device of Luciano. Consequently, and for various reasons, the appellant and her representative do not believe that one of ordinary skill in the art would find the key ring of Luciano to teach the use of a key in combination therewith.

Each of the independent claims specifically recite the key as a part of the inventive combination. The key is not illustrated and claimed merely as a ploy to somehow render the obvious patentable or to otherwise make the Examiner's job more difficult. Instead, there is surprising synergy obtained from this specific combination of key, key ring, and educational tag. As described in the specification between page 8, line 10 and page 9, line 1, a typical person in getting to and from work and around at lunch will access their keys eight different times. This does not count uses during work, or additional keys such as health club lockers, recreational vehicles, garage door keys, or the myriad of other places where keys are required. As noted in the specification, locks and keys are ubiquitous, forcing a typical adult to access them many times during the day. The appellant has recognized this fact, and created an apparatus and method to use these necessary key accesses for additional educational purpose. The Board will recognize that none of the references of record, including Luciano and Peckham, in any way forecast or taught this benefit. Consequently, while the apparatus of the present invention might appear to be deceptively simple, the benefit attained therefrom is most surprising, and not anticipated, suggested or taught by the prior art. Instead, even the key ring of Luciano is only



provided by coincidence, and does not teach or suggest either the apparatus or the method of the present invention.

In addition to the first issue before the Board, which addresses whether the Luciano reference teaches the use of a key in combination with ring and educational tag, there are additional issues that the appellant respectfully requests relief from. More particularly, with regard to claims 7 - 10, the appellant specifically recites a method for expanding vocabulary. The Examiner is silent on the specific steps recited therein, and instead merely states: "Regarding method claims 7-10, 16, and 17, the combination of Peckham and Luciano would constitute the obvious steps as set forth in those claims." As aforementioned, those steps result in a review of the educational matter multiple times throughout an entire day, a feature which neither Luciano nor Peckham teach or illustrate. In particular reference to claim 7, for exemplary purposes, the steps of inserting an imprinted tag onto a key ring with a key, transporting the key ring, key and tag through the elements, stowing the retrieved key ring, and studying the imprinted tag between retrieving and stowing are not illustrated or taught by the apparatus, and special consideration is requested in the event the Board should find the apparatus is taught or suggested.

With regard to claims 8 and 14, the step of imprinting a single tag on demand is not taught or suggested by either Peckham or Luciano, and has much advantage. With regard to claims 9 and 10, the use of the key and storing with the key are further emphasized. With regard to claim 15, the ability to compactly store the present tags when not in use is certainly not taught by either Peckham or Luciano. With regard to claims 16 and 17, the ability to reuse the present invention on a daily basis for an entire year is not taught nor suggested. Instead, Peckham requires that all tags be carried simultaneously, and Luciano teaches the requisite need to carry a book with.

For these aforesaid reasons, the applicants respectfully request relief from the Examiner's final rejection by the Board of Appeals of the rejections based upon 35 U.S.C. 103.

V. REJECTIONS FOR OTHER REASONS

There are no outstanding rejections based upon reasons other than those listed above.

CONCLUSION

The appellants' representative thanks the Examiner for the telephonic interview of November 25, 2002, during which the Luciano reference was discussed and from which no agreement was reached. The Examiner's time is appreciated in discussing the issues at hand. For the reasons outlined herein above, the Board of Appeals is requested to consider and reverse the rejections by the Examiner. An appendix of all pending claims is attached.

Respectfully,

A handwritten signature in black ink, appearing to read 'Albert W. Watkins', with a stylized flourish at the end.

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## APPENDIX OF CLAIMS

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The claims, as they are at the time of appeal.

1. A portable and unobtrusive educational apparatus which provides self-paced instruction and which is carried by a person without requiring special accommodation or space, and which may be easily and flexibly manufactured and packaged compactly, comprising the combination of:

5 a key which is operative to open a lock and permit access which is otherwise prevented by said lock;

a key ring which operatively prevents inadvertent attachment or removal of said key while operatively permitting intentional insertion or removal;

10 a plurality of educational key tags, each one of said plurality fabricated from a durable and weather resistant planar material having a means for attaching said tag to said key ring which is operatively prevented from inadvertent attachment or removal while operatively permitted intentional attachment or removal from said key ring, said tag additionally presenting an educational challenge displayed on a first surface and presenting an answer appropriate to said challenge, said answer normally concealed when said educational challenge is visible;

15 wherein at least one of said plurality of educational key tags is attached to said key ring.

4. The portable and unobtrusive educational apparatus of claim 1 wherein said plurality of educational key tags are further comprised by a reinforced polymeric composition that is both durable and mark resistant.

5. The portable and unobtrusive educational apparatus of claim 1 wherein said plurality of educational key tags are further comprised by a paper and polymer laminate.

7. A method for expanding vocabulary, comprising the steps of:

identifying vocabulary words and definitions that define each of said vocabulary words;

imprinting said identified vocabulary words onto tags on a first surface thereon, one of said vocabulary words for each one of said tags;

5 imprinting said definitions that define said vocabulary words onto said tags on a second surface thereon opposed to said first surface wherein each tag contains at least one vocabulary word and at least one definition that defines said at least one vocabulary word;

selecting a one of said imprinted tags;

10 inserting said selected one imprinted tag onto a key ring together with a key removably attached therewith;

storing said key ring, said key and said inserted, imprinted tag;

retrieving said stored key ring;

transporting said key ring, said key and inserted, imprinted tag through the natural elements without shelter;

15 stowing said retrieved key ring; and

studying said selected one imprinted tag between said step of retrieving and said step of stowing.

8. The method of claim 7 wherein said step of imprinting comprises the step of printing a single tag on demand.

9. The method of claim 7 wherein said step of storing further comprises storing a key with said key ring.

10. The method of claim 9 further comprising the step of using said key on said retrieved key ring between said step of retrieving and said step of stowing.

11. A key set and educational aid for convenient and self-paced education, comprising:

a spirally wound resilient metal key ring having a full turn of metal and an additional wrap of metal overlapping said full turn, thereby forming a region of overlap between said full turn and said additional wrap, said full turn and said additional wrap resiliently biased into  
5 contact with each other within said region of overlap;

a key having a lock engaging body and a head engaging said key ring, a hole passing through said head through which said additional wrap may be passed by resiliently biasing said full turn and said additional wrap temporarily apart from each other and passing said additional wrap through said hole; and

10 a plurality of planar paper-based tags, each of standard key size having a hole passing through said tag through which said additional wrap may be passed by resiliently biasing said full turn and said additional wrap temporarily apart from each other and passing said additional wrap through said tag hole, and further having a word on a first major surface and a definition of said word on a second major surface of said planar tag opposed to said first major surface;

15 said key, key ring and at least one of said plurality of planar tags operatively retained to each other;

wherein said key, key ring and said at least one of said plurality of planar tags are

operatively transportable through the elements.

12. The portable and unobtrusive educational apparatus of claim 1 wherein said educational challenge further comprises a word, and said answer further comprises a definition.

13. The portable and unobtrusive educational apparatus of claim 5 wherein said educational challenge is imprinted upon said paper and polymer laminate.

14. The portable and unobtrusive educational apparatus of claim 13 wherein said educational challenge is imprinted on demand.

15. The portable and unobtrusive educational apparatus of claim 1 further comprising a storage box having an interior for receiving said plurality of educational key tags in stacked arrangement therein.

16. The method of claim 7 wherein said step of imprinting further comprises imprinting three hundred and sixty five of said words and three hundred and sixty five of said definitions onto three hundred and sixty five of said tags.

17. The method of claim 16 further comprising the step of:

removing said selected one of said imprinted tags and replacing said selected one with a new tag selected from said imprinted tags on a daily basis, to introduce a new word and definition daily.